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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,730	02/10/2006	Kaori Ito	082414-000500US	7675
20350 7590 04/29/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER ABRAHAM, AM/AD A				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
04/29/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/567,730

Applicant(s)

ITO, KAORI

Examiner

AMJAD ABRAHAM

Art Unit

1791

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 7-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date 02/02/2009.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's remarks and amendments, filed on January 28, 2009, have been carefully considered. Claims 4 and 7-12 have been canceled. Claims 1-3 and 5-6 are still pending.

Information Disclosure Statement

1. Examiner withdraws the objection to the IDS as stated in the previous office action dated October 28, 2008 due to applicant's submission of a new IDS.

Drawings

2. Examiner withdraws the objection to the drawings as stated in the previous office action dated October 28, 2008 due to applicant's amendment of claim 1.

New Grounds of Rejections based on applicant's amendments filed on January 28, 2009

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. *Claims 1-3 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka (Japanese Patent Publication JP 11028856) in view of Aoki et al. (Japanese Patent Publication JP 02001239779 A).*

2. Regarding claim 1, Yamaoka teaches a decorating method used to impart and/or print a design print layer onto a resin molded article. **(See paragraphs 0001-0003).**

a. Yamaoka further teaches:

- i. A step of forming a transfer sheet by forming an ink receiving layer on a base material sheet.

(1) **(See drawings 1-2 showing a transfer sheet (part #1) with a peeling layer (part #3 corresponds to base material sheet) and an ink absorbing layer (part #6)**

- ii. A step of inserting the transfer sheet into a cavity of a metal mold where the ink receiving layer faces a room of the mold and the step of injecting the resin. **(See drawing 5 showing the transfer sheet being placed into a mold and injected with resin).**

iii. Thereby molding a base which is attached to the transfer sheet.

(See drawing 5 and paragraph 0001-0003 disclosing the injection molding of a resin material onto the transfer sheet in order to impart the ink receiving layer onto the resin molded product.)

iv. A step of ejecting the mold and peeling (exfoliating) the base material from transfer sheet leaving molded product and ink layer. **(See paragraph 0003).**

b. With respect to claim 1, Yamaoka does not expressly teach wherein a step of performing printing to said ink receiving layer after the injection molding process and ejection of molded product.

c. However, Yamaoka teaches, that post mold printing is not used in their method only because their process deals with molded products that have curved surfaces. **(See description of prior art or paragraph 0002).**

v. It is well known in the art that a card like a credit card can be printed on even after the final card is made. Yamaoka teaches this well known idea as it clearly states that when dealing with flat molded articles, (which can include credit cards) one can print on the article. **(See description of prior art or paragraph 0002).** Therefore, it would have been obvious to one having the ordinary skill in the art to alter the teachings of Yamaoka to include post mold printing when making a card base as claimed since card like credit cards are typically flat.

- vi. Furthermore, post mold printing can include printing by hand. This is well known in the art as almost every credit card has an area which can be printed on the back 9 for example signature section).
 - d. With respect to claim 1, Yamaoka does not explicitly teach the use of a transfer sheet in the manufacture of a card.
 - e. However, Aoki teaches the use of transfer sheet molding in the manufacture of a card. **(See claim 1 and paragraphs (0001-0004) which discloses the use of an ink receiving layer to make a card.)**
 - f. Yamaoka and Aoki are analogous art because they are from the same field of endeavor which is transferring an ink receiving layer unto a molded product. At the time of invention, it would have been obvious to the applicant being one of ordinary skill in the art, having the teachings of Yamaoka and Aoki before him or her, to modify the teachings of Yamaoka with the teachings of Aoki for the benefit of making a card that can be easily printed on by an ink jet printer. The motivation for doing so would have been to allow many businesses to order mass produced cards which then can be printed on on-site. Therefore, it would have been obvious to combine Yamaoka and Aoki to obtain the invention as claimed in claim 1.
3. In claim 2 Yamaoka does not explicitly teach wherein said ink receiving layer is formed of a heat-curable hydrophilic resin.

- g. However, Aoki teaches wherein said ink receiving layer is formed of a heat-curable hydrophilic resin. **(See claim 1 disclosing the use of a heat curable hydrophilic resin.)**
- h. Yamaoka and Aoki are analogous art because they are from the same field of endeavor which is transferring an ink receiving layer unto a molded product. At the time of invention, it would have been obvious to the applicant being one of ordinary skill in the art, having the teachings of Yamaoka and Aoki before him or her, to modify the teachings of Yamaoka with the teachings of Aoki for the benefit of using a hydrophilic resin as the ink receiving layer to allow printing on the card post production with a water based ink. The motivation for doing so would have been to allow the use of water based inks; as water based inks are common in ink-jet printers. Therefore, it would have been obvious to combine Yamaoka and Aoki to obtain the invention as claimed in claim 2.
4. In claim 3 Yamaoka teaches adding an anchor **(adhesive)** layer for enhancing air tightness of said ink receiving layer to said card base is pre-formed on said ink receiving layer. **(See paragraph [0003] and drawing 1 disclosing part number (5) which is an adhesive and added prior to molding.)**
5. In claim 5 Yamaoka teaches wherein said printing is executed by an ink-jet printer. **(See claim 1 and paragraph [0011] disclosing the use of an ink jet printer to print.)**

6. In claim 6 Yamaoka does not explicitly teach adding a step of covering the surface of said ink receiving layer with a cover layer after printing is applied to said ink receiving layer.

i. However, Aoki teaches adding a step of covering the surface of said ink receiving layer with a cover layer after printing is applied to said ink receiving layer. **(See paragraph [0010] disclosing the use of a cover layer on top of the printed layer.)**

j. Yamaoka and Aoki are analogous art because they are from the same field of endeavor which is transferring an ink receiving layer unto a molded product. At the time of invention, it would have been obvious to the applicant being one of ordinary skill in the art, having the teachings of Yamaoka and Aoki before him or her, to modify the teachings of Yamaoka with the teachings of Aoki for the benefit of using a resin to cover the just printed ink layer in order to protect the decoration from abrasions. The motivation for doing so would have been to extend the useful life of the printed decoration. Therefore, it would have been obvious to combine Yamaoka and Aoki to obtain the invention as claimed in claim 6.

Response to Arguments

5. Applicant's arguments filed January 28, 2009 have been fully considered but they are not persuasive and/or moot in view of new grounds of rejection.

6. **Applicant's Argument:** "That the Yamaoka reference does not teach printing on the ink receiving layer after the card base is taken out of the mold."

7. **Examiner's Response:** The Yamaoka reference teaches that when making a flat product like a credit card it is well known in the art to print, stamp, or transfer a pattern on an injection molded article. Yamaoka teaches the making of a curved product. Yamaoka appreciates the fact that it is difficult to preform a necessary printing operation on a curved card. Yamaoka goes on to say that transfer sheet molding is the solution to this problem. Because of the difficulty of printing on a curved surface one having the ordinary skill in the art would look to print the pattern on a transfer sheet first and transfer the sheet to the injection molded product and thereby eliminating the need for post mold printing. Furthermore, it is well known that a printing operation can be done to many types of card bases such as ATM cards or credit cards which can be printed on by well known card printers. In addition, said printing can be done by hand and are known as credit card typically have writable portions on the back of the card.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMJAD ABRAHAM whose telephone number is (571)270-7058. The examiner can normally be reached on Monday through Friday 8:00 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAA

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791